

**REMARKS**

In response to the Office Action mailed October 27, 2003, Applicants respectfully request reconsideration. To further the prosecution of this application, each of the rejections set forth in the Office Action has been considered and addressed below.

Claims 1, 2, 15-26, 51-60, 68, and 73-76 are pending in this application, of which claims 1, 51, 68, 74, 75, and 76 are independent claims. Dependent claims 8-14 and 69-72 currently are withdrawn from consideration due to a previous restriction requirement, but are entitled to consideration upon the allowance of any base claims from which they depend, pursuant to MPEP §809.04.

In this amendment, claims 41, 42, 45-48, 50, and 61-67 are cancelled. None of the remaining claims is amended. The specification and drawings have been amended to address a previously inconsistent amendment in the specification and drawings, as discussed further below. The application as now presented is believed to be in allowable condition.

A. Allowed Claims

Applicants note with appreciation that the Examiner has allowed claims 75 and 76.

B. Claim Rejections Under 35 U.S.C. §103

On page 4 of the Office Action, claims 1, 2, 15-26, 51-54, 56-60, 68, 73 and 74 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Havel (U.S. Patent No. 5,283,517). Applicants respectfully traverse the rejections of these claims.

1. "Intended Use"

As can be best understood from the Office Action, the stated basis for rejecting each of independent claims 1, 51, 68, and 74 appears to involve a concept referred to by the Examiner as "intended use."

Notably, the Examiner concedes that Havel fails to disclose or suggest at least one limitation positively recited in the body of each rejected independent claim; however, the Examiner alleges that somehow Havel nonetheless provides a proper bases for rejecting the claims, notwithstanding the missing limitations, because the missing limitations are "merely intended uses" (see Office Action, pages 4 and 10).

In connection with the so-called "intended use" concept apparently relied upon by the Examiner, Applicants' representative is not aware of any rule or doctrine set forth in the patent statutes, the patent rules, or the MPEP regarding "intended use" that in any way could possibly be related to the rejection of the present claims.

The phrase "intended use" does appear in MPEP §1503.01 and in 37 C.F.R. §1.154(b)(1), with respect to the specification of a design patent. In particular, both MPEP §1503.01 and in 37 C.F.R. §1.154(b)(1) state that the specification of a design patent "should include the following sections in order: (1) Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and *intended use* of the article in which the design is embodied...." (italics added).

The phrase "intended use" also appears in MPEP §806.05(e) in connection with restriction requirements, in a section entitled "Process and Apparatus for Its Practice-Distinctness." This section discusses when a restriction requirement may be supported by showing that a process and apparatus for its practice are distinct inventions. In analyzing when a claim may not serve as a linking claim in such a restriction, MPEP §806.05(e) states that "it should be noted that a claim such as, 'An apparatus for the practice of the process of claim 1, comprising ....' and then the claim continues with purely apparatus limitations, is not a linking claim. This is merely a preamble similar to a statement of *intended use* and should be treated as any preamble" (italics added).

The phrase "intended use" also appears in MPEP §2106 II(C) regarding patentable subject matter in computer-related inventions. More specifically, this section of the MPEP discusses the interpretation of claims for examination of computer-related inventions. MPEP §2106 II(C) states that:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim: (A) statements of *intended use* or field of use, (B) "adapted to" or "adapted for" clauses, (C) "wherein" clauses, or (D) "whereby" clauses. This list of examples is not intended to be exhaustive (italics added).

Again, Applicants respectfully submit that the foregoing references to “intended use” in the above-indicated authorities do not appear to be at all relevant to the claims at issue in the present application. If the Examiner is relying on some other authority in support of his rejections of the claims based on so-called “intended use,” the Examiner is respectfully requested to cite this authority. Otherwise, the rejections of the claims as set forth in the Office Action should be withdrawn, as discussed further below.

## 2. Obviousness Criteria

As set forth in MPEP § 2143, three criteria must be met in order to establish a *prima facie* case of obviousness. First, there must be some specific suggestion or motivation, either in the cited reference(s) or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s). Second, there must be a reasonable expectation of success. The specific teaching or suggestion to modify the reference(s), as well as the reasonable expectation of success, must both be found in the prior art and not based on Applicants’ disclosure. Third, the reference(s) must teach or suggest all of the claimed features.

In the present application, the Examiner has significantly failed to establish a *prima facie* case of obviousness.

First, as discussed above, the cited Havel reference fails to disclose or suggest one or more features recited in each of Applicants’ rejected independent claims; specifically, at least one element of each rejected independent claim is *entirely missing* from and *not suggested* in Havel. For at least this reason, the obviousness rejections are improper, as the third obviousness criterion stated above is not met.

Second, the Examiner has completely failed to point to any specific motivation or suggestion in the prior art to modify the cited Havel reference to provide the missing claim elements. To support an obviousness rejection, the Examiner must specifically identify a motivation to change the prior art to fall within the scope of the claims. If the Examiner fails to clearly and particularly identify in the prior art any suggestion, teaching, or motivation to modify a reference, the rejection cannot be maintained.

With respect to such suggestion or motivation, in the present case the Examiner has clearly failed to meet this obviousness criterion. Instead, as discussed above, the Examiner merely offers the wholly unintelligible assertion that the missing claim elements constitute an

“intended use. And [sic] such suggestion does not change the scope of Havel’s invention.”

Applicants’ representative respectfully submits that he has absolutely no idea what the Examiner is referring to by such an assertion.

Furthermore, in connection with independent claims 68 and 74, the Examiner appears to suggest that the mere alleged *capability* of Havel to provide the missing features is enough to render these claims obvious. This reasoning is legally untenable. It is well settled that the mere fact that references can be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Finally, the Examiner fails to point to any evidence in the prior art that there is any reasonable expectation of success in modifying the cited Havel reference to provide the missing elements required by Applicants’ claims. In fact, there is absolutely no evidence in Havel or any other reference of record that the teachings of Havel are at all suitable for, or applicable to, Applicants’ claimed methods or apparatus.

In sum, the Examiner has failed to meet his burden with respect to each of the three criteria required to establish a *prima facie* case of obviousness. Failure to meet any one of these criteria – a teaching or suggestion of all claim elements, a specific suggestion or motivation to modify the prior art, and a reasonable expectation of success – is sufficient to render such a rejection improper. In the present case, *the Examiner’s basis for rejection is deficient with respect to all three criteria*. Accordingly, the rejections must be reversed.

### 3. Discussion of Havel

Havel is directed to a variable color digital multi-meter including four 7-segment alpha-numeric LED display elements (Figs. 19, 20 and other figs). Essentially, Havel’s multi-meter is a measuring instrument with a variable-color digital display readout (col. 2, lines 5-7). In various embodiments of Havel’s meter, each segment of a given 7-segment alpha-numeric display may include multiple different color LEDs (e.g., one red LED, one green LED and one blue LED) (col. 7, lines 31-38 and lines 49-54; Figs. 8 and 9). By selectively energizing the different color LED segments, the entire display may provide alpha-numeric information (measured voltages, currents, resistances, etc.) in one of a variety of colors.

4. Claim 1

Claim 1 is directed to a method for attracting attention from an observer to a retail display. The method of claim 1 comprises acts of: 1) providing an LED system to generate light of a range of colors within a color spectrum; 2) placing the LED system to project the light, when generated, onto the retail display such that the observer sees at least some of the light substantially indirectly via the retail display, and not directly from the LED system; and 3) generating the light so as to illuminate the retail display.

Havel does not remotely teach or suggest the method of claim 1. In particular, Havel neither discloses nor suggests a retail display, or using Havel's multi-meter any other lighting system to illuminate a retail display (or any other object of any kind). There simply is no teaching in Havel that remotely suggests that the disclosed multi-meter would reasonably be expected to be successful at illuminating a retail display (or any other object) so as to draw an observer's attention to the retail display. Rather, the teachings of Havel are limited to a digital multi-meter with a variable-color alpha-numeric display which, at best, draws attention to *itself*. Specifically, there is no disclosure or suggestion whatsoever in Havel, or in any other reference of record, that would lead one of ordinary skill to reasonably expect that Havel's multi-meter would provide a sufficient brightness to adequately illuminate a retail display so as to attract attention to the retail display. The mere proposition of using a digital multi-meter to illuminate a retail display borders on the absurd.

In the Office Action, the Examiner concedes that Havel "fails to disclose the display being used as retail [sic] display, and observer [sic] sees the light indirectly via the display" (Office Action, page 4 ¶3). The Examiner asserts, however, that "the usages [sic] of Havel's display in retail use, the usages [sic] of observer in seeing the light from different angle [sic] or direction (e.g., indirectly) are considered as intended use. And [sic] such suggestion does not change the scope of Havel's invention."

While the Examiner's comments here are somewhat convoluted at best, even the most generous reading of these comments reveals that the basis of the obviousness rejection is legally insufficient. In particular, the Examiner points to no specific suggestion or motivation whatsoever in the prior art to modify Havel in any manner; instead, the Examiner merely makes the foregoing "intended use" assertion without pointing to a single prior art reference that mentions the illumination of a retail display in any manner, and without citing to any authority in

support of his so-called "intended use" basis for rejection. That the Examiner suggests that a *digital multi-meter* may be used to effectively illuminate a retail display in the manner recited in claim 1 is simply disingenuous.

For at least the foregoing reasons, the Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness with respect to claim 1. Therefore, the rejection of claim 1 over 35 U.S.C. §103(a) as allegedly being obvious over Havel should be withdrawn.

Claims 2, 15-26, and 58-60 depend from claim 1 and are allowable for at least the same reasons. Claims 8-14 also depend from claim 1, but currently are withdrawn from consideration due to a previous restriction requirement; since claim 1 is believed to be in allowable condition, these claims are believed to be entitled to consideration.

5. Claim 51

Independent claim 51 is directed to a method for illuminating a retail display. The method comprises acts of providing an LED system that generates light of a range of colors within a color spectrum in response to an activation signal, directing the light toward the retail display, and controlling the activation signal to vary the range of colors of the light over time, whereby the retail display is affected with color-changing illumination.

As discussed above in connection with claim 1, Havel does not disclose or suggest a retail display, nor directing light toward the retail display such that the retail display is affected with color-changing illumination, as recited in claim 51. For reasons similar to those discussed above in connection with claim 1, claim 51 patentably distinguishes over Havel and is in condition for allowance. Therefore, the rejection of claim 51 over 35 U.S.C. §103(a) as allegedly being obvious over Havel should be withdrawn.

Claims 52-54, 56, and 57 depend from claim 51 and are allowable for at least the same reasons.

6. Claim 68

Independent claim 68 is directed to a method for attracting attention from an observer. The method comprises acts of providing an LED system to generate light of a range of colors within a color spectrum, placing the LED system to project the light, when generated, onto an object such that the observer sees at least some of the light substantially indirectly via the object

and not directly from the LED system, the object being selected from the group consisting of a display case, a vending machine, a beverage container, and an advertising display, and generating the light so as to illuminate the object.

Havel does not remotely disclose or suggest the various objects that are illuminated according to the recitations in method claim 68, such as a display case, a vending machine, a beverage container, and an advertising display. More generally, as discussed above, Havel neither discloses nor suggests any lighting system that projects light onto any other object for the purposes of attracting attention from an observer to the object. Again, the Examiner concedes as much in the Office Action (Page 10, ¶1). As with the other rejected independent claims, however, the Examiner posits an “intended use” basis for rejecting claim 68:

[U]sage of projecting the light and using [sic] in advertising display are merely intended uses. And [sic] such suggestion does not change the scope of Havel's invention. Since Havel is capable of showing numbers in different colors, it is also capable of using the advertising purpose as well such as showing prices or alphabets.

Again, Applicants' representative is entirely unclear as to the meaning of the Examiner's assertions in the foregoing passage. In any event, as discussed above, the alleged capability of Havel to provide the missing features is not enough to render claim 68 obvious; the mere fact that references can be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification.

For at least the foregoing reasons, claim 68 patentably distinguishes over Havel and is in condition for allowance. Therefore, the rejection of claim 68 over 35 U.S.C. §103(a) as allegedly being obvious over Havel should be withdrawn.

Claim 73 depends from claim 68 and is allowable for at least the same reasons. Claims 69-72 also depend from claim 68, but currently are withdrawn from consideration due to a previous restriction requirement; since claim 68 is believed to be in allowable condition, these claims are believed to be entitled to consideration.

#### 7. Claim 74

Independent claim 74 is directed to an illumination method, comprising acts of providing an LED system to generate light of a range of colors within a color spectrum, and placing the

LED system to project the light, when generated, onto an object so as to illuminate the object. The object is selected from the group consisting of a display case, a vending machine, a beverage container, and an advertising display. The LED system is positioned such that at least some of the projected light, upon illumination of the object, is directed to an observer so that the observer sees at least some of the projected light substantially indirectly via the object, and not directly from the LED system.

For reasons similar to those discussed above in connection with claim 68, claim 74 patentable distinguishes over Havel and is in condition for allowance. Therefore, the rejection of claim 74 over 35 U.S.C. §103(a) as allegedly being obvious over Havel should be withdrawn.

C. General Comments on the Dependent Claims

For the sake of brevity, Applicants believe that it is unnecessary at this time to argue the allowability of each of the dependent claims individually. However, Applicants do not concur that the basis for the rejection of any of the dependent claims is proper. In fact, at least some dependent claims recite features that are completely absent from, and not suggested by, the Havel reference. Therefore, Applicants reserve the right to specifically address the separate patentability of each dependent claim in the future, if deemed necessary.

D. Amendments to the Specification and Drawings

The specification and drawings have been amended to address a previously inconsistent amendment in the specification and drawings.

In a first Office Action mailed April 12, 2000 in this application, the drawings were objected to for not showing all claimed features. In particular, the Office Action noted that the sensor, receiver and transmitter of original claims 46 and 48 needed to be shown in the figures or canceled from the claims.

In a response mailed July 12, 2000, the Applicants amended Fig. 100 to clearly indicate the sensor, receiver and transmitter recited in the claims. In the response, Applicants also amended the specification on page 141, in connection with a discussion of Fig. 100, to ensure that reference numerals for the features illustrated in Fig. 100 were appropriately indicated in the specification.



In a second Office Action mailed October 4, 2000, the objections to the drawings were withdrawn.

In a fourth Office Action mailed October 10, 2001, the drawings again were objected to for allegedly failing to show the sensor recited in claim 46. In a response mailed March 11, 2002 to the fourth Office Action, Applicants inadvertently again amended Fig. 100 and the specification to indicate a sensor.

Accordingly, in the present amendment, Applicants have again amended Fig. 100 and the specification on page 141 to un-do the inadvertent amendment of the specification and drawings in the March 11, 2002 response.

E. Information Disclosure Statements

Applicants note that for Information Disclosure Statements (IDSs) filed on April 5, 2001 and September 24, 2003 in the present application, Applicants have not yet received copies of the Forms PTO-1449 initialed by the Examiner to indicate consideration of the references cited therein. Applicants respectfully request that the Examiner acknowledge reviewing the references cited in these IDSs by providing, in subsequent correspondence to the Applicants, an initialed copy of the Forms PTO-1449 for these IDSs.

F. Conclusion

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' attorney at the telephone number listed below to discuss any outstanding issues relating to the allowability of the application.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 50/2762.

Respectfully submitted,  
*Ihor Lys, et al., Applicants*

By: 

Joseph Teja, Jr., Reg. No. 45,157  
LOWRIE, LANDO & ANASTASI, LLP  
One Main Street  
Cambridge, Massachusetts 02142  
United States of America  
Telephone: 617-395-7000  
Facsimile: 617-395-7070  
Attorneys for Applicant

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